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Supreme Court, U.S.
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In the Supreme Court of the United States

ISI INTERNATIONAL, INC.,

Petitioner,

v.

BORDEN LADNER GERVAIS LLP, and BORDEN ELLIOT SCOTT & AYLEN,

Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Seventh Circuit

RESPONDENTS' BRIEF IN OPPOSITION

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QUESTIONS PRESENTED

1. A Canadian lawyer sent a cease-and-desist letter to a prospective U.S. distributor on behalf of the inventor of a device for which a patent application was then pending. The letter stated, incorrectly, that the inventor had a patent for the device. Did the Seventh Circuit err when it ruled that this single private communication did not constitute "commercial advertising or promotion" under the false advertising provisions of the Lanham Act?

2. Did the Seventh Circuit err when, based on well-established precedent governing state citizenship under 28 U.S.C. § 1332(a), it ruled that a U.S. citizen permanently domiciled in Canada was not a citizen of any U.S. state?

PARTIES TO THE PROCEEDING AND STATEMENT PURSUANT TO RULE 29.6

The parties to this action are set forth in the case caption. Borden Elliot Scott & Aylen is a partnership organized under the laws of Ontario. Borden Ladner Gervais LLP is a limited liability partnership organized under the laws of Ontario. Neither partnership is publicly traded, and no publicly held company owns 10% or more of either partnership.

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STATEMENT OF THE CASE

1. Background[1]

In 1994, Dr. Bert Reitsma, a Dutch physician living in Ontario, Canada, retained Scott & Aylen ("S&A"), an Ottawa, Ontario firm comprised of barristers and solicitors, and a separate partnership of patent agents. Pet. App. 47; Opp. App. 1. Reitsma asked one of S&A's solicitors to form ISI Surgical Instruments Canada, Ltd. ("ISI Canada"), as an Ontario corporation to commercialize his invention, a device for draining surgical wounds. Pet. App. 4-5. Reitsma also retained a S&A patent agent to obtain patent protection for the invention. *Id.* at 5. The S&A patent agent hired a Michigan law firm to prosecute the U.S. patent application. *Id.*

Reitsma later licensed ISI Canada with the worldwide rights to his invention. *Id.* at 5, 47. The license agreement specified that disputes were to be adjudicated in Ontario under Ontario law. *Id.* at 5. In 1996, Petitioner ISI International, Inc. ("ISI" or "Petitioner"), an Illinois corporation, acquired ISI Canada, and ISI Canada assigned the Reitsma license to ISI. *Id.* at 22, 29. Within a year, Reitsma had a falling out with ISI's principals, and he sent ISI a notice terminating the license. *Id.* at 22, 47. To protect his rights in the invention, Reitsma asked S&A to notify two prospective distributors that he had terminated ISI's license to the invention. *Id.* at 5-6. On Reitsma's behalf, a S&A solicitor sent one letter to a prospective U.S. distributor, American Pharmaceutical Partners ("APP"), and a second

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[1] The background facts are drawn from ISI's pleadings, which have been taken as true except where contradicted by the affidavits that Respondents filed in accordance with the practice under F. R. Civ. P. 12(b)(3). *See, e.g.*, *Van Cauwenberghe v. Biard*, 486 U.S. 517, 529 (1988) (*forum non conveniens* "may be resolved on affidavits presented by the parties").

letter to a prospective distributor in The Netherlands. *Id.* at 22, 52-53. The letters stated, incorrectly, that Reitsma owned the patent for the device; at the time, Reitsma's U.S. patent application was still pending. *Id.* Contrary to the representation in the ISI Petition (Pet. at 6), the letters did ***not*** "solicit[ ] the recipients to do business with Dr. Reitsma, rather than ISI." In fact, the letters do not contain any such solicitation. *Id.* at 52-53.

2. ISI's Chicago Lawsuit

In 1998, ISI sued S&A in the U.S. District Court for the Northern District of Illinois, alleging, *inter alia*, that S&A's letter to APP constituted "false advertising" under the Lanham Act, because it stated, incorrectly, that Reitsma had a patent for the device. *Id.* at 36; Opp. App. 7-8. Contrary to the assertion in ISI's Petition that the Lanham Act claim is based on a "series of letters sent to ISI's customers" (Pet. at 6), ISI's Lanham Act claim is based exclusively on a single letter that S&A sent to APP.[2] Opp. App. 9-10. In addition to its Lanham Act claim, ISI alleged various state law claims against S&A. Pet. App. 20.

The district court dismissed ISI's complaint for lack of personal jurisdiction over S&A, and on *forum non conveniens* grounds. *Id.* at 1-3. The Seventh Circuit reversed the personal jurisdiction dismissal, finding that S&A's national contacts were sufficient for jurisdiction under F. R. Civ. P. 4(k)(2), and remanded for further consideration of the *forum non conveniens* issue. *Id.* at 14-16. The Seventh Circuit also substituted Respondent

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[2] *See* Count 1 of ISI's First Amended Complaint, ¶ 66 ("The representations in the APP Letter constitute false representations in violation of ISI's rights under Section 43(a) of the Federal Lanham Act."). Opp. App. 10.

Borden Ladner Gervais LLP ("BLG") as a "placeholder" defendant. *Id.* at 17-19.

3. Formation of BLG

Long after the events giving rise to this case, S&A and its partners underwent several organizational changes. In early 1998, S&A's patent agents and lawyers combined their separate partnerships into a single partnership. Opp. App. 2. Later that year, in anticipation of a proposed merger with a Toronto firm named Borden & Elliot, S&A officially changed its name to Borden Elliot Scott & Aylen ("BESA"). Pet. App. 38; Opp. App. 3. However, that merger never took place. Instead, in early 2000, the partners of five leading Canadian law firms (the "Legacy Firms"), including Borden & Elliot and BESA, formed BLG, a new national Canadian law firm. Pet. App. 38-39. All of the agreements forming BLG, including the provisions addressing the assumption of liabilities of the Legacy Firms, are governed by Canadian law. *Id.* at 31, 39. BESA continues to exist, and remains responsible for its own liabilities. *Id.* at 38-39. Nevertheless, the Seventh Circuit *sua sponte* substituted BLG as a "placeholder" defendant. *Id.* at 19. In so doing, the Seventh Circuit expressly noted that it did "not mean to imply that [BLG] has assumed any of [S&A's] liabilities. [BLG] serves for now only as a placeholder." *Id.*

4. The First Remand And Appeal

Following the Seventh Circuit's initial decision in this case, ISI filed in the district court (on remand) an amended complaint naming only BLG as a defendant. Opp. App. 9. BLG, joined by BESA, asked the district court to first consider the substitution of defendants issue. Pet. App. 20. BLG and BESA also moved to dismiss on *forum non*

conveniens grounds, arguing that the key legal issues were governed by Canadian law, that many material witnesses could only be compelled to testify if the case were tried in Ontario, and that ISI had failed to identify any non-party witnesses who could be compelled to testify in Illinois. *Id.* at 20. In addition, BLG and BESA moved to dismiss for failure to state a claim under F. R. Civ. P. 12(b)(6), arguing that S&A's letter to APP did not constitute "commercial advertising and promotion" under the Lanham Act. *Id.* at 31.

In its October 30, 2001 opinion, the district court, applying the *forum non conveniens* analysis set forth in *Piper Aircraft Co. v. Reyno*, 454 U.S. 235, 256 (1981), first found that Ontario was an adequate alternative forum. *Id.* at 25-26. The district court then concluded that Ontario was the more appropriate forum because the public interest factors—including the overarching issues of Canadian law—and the private interest factors—including the unavailability of key testimony if the case were to be tried in Chicago—strongly favored Ontario as the appropriate forum. *Id.* at 26-31. The district court dismissed the action on *forum non conveniens* grounds, and ruled that the substitution of defendants issue and the motion to dismiss ISI's Lanham Act claim were moot. *Id.* at 32. ISI appealed that decision, and the Seventh Circuit summarily remanded for a determination as to the proper defendant. *Id.* at 35.

5. The Second Remand

Following discovery and an additional round of briefs on the issue of whether BLG has assumed liability for S&A's torts, the district court held that on the record before it, it could not determine whether BLG had assumed those liabilities. *Id.* at 43. Significantly, the district court

found that the issue of BLG's successor liability turned on "[t]he validity and enforceability of the March 1, 2000 letter agreement [which] involves complex issues of Ontario contract, partnership, and successor liability law." *Id.* at 39. The district court found that the existence of these complex issues of Ontario law "reinforce[d]" the conclusion that "ISI's action belongs in Ontario, not Illinois." *Id.* at 44. For that reason, and for the other reasons set forth in its October 30, 2001 opinion, the district court again dismissed ISI's lawsuit on *forum non conveniens* grounds. *Id.*

6. The Seventh Circuit Affirmance

On appeal, the Seventh Circuit questioned the district court's balancing of the public and private interest factors in its *forum non conveniens* analysis. *Id.* at 48-49. Nevertheless—in one of two independent and equally dispositive rulings—the Seventh Circuit affirmed the district court's dismissal on *forum non conveniens* grounds. *Id.* at 49-51. In a unanimous decision written by Circuit Judge Easterbrook, the court held that because an Ontario court ultimately would have to resolve the successor liability issues with respect to any judgment that ISI obtained, the Ontario court should handle the whole suit: "If this aspect is going to land in Ontario no matter what, why not handle the whole suit there?" *Id.* at 49.

The Seventh Circuit then ruled, alternatively, that regardless of the *forum non conveniens* dismissal, ISI's Lanham Act claim was untenable because "§43(a)(1)(B) *** is limited to false or misleading 'commercial advertising or promotion'" and that "letters sent to customers do not come with the scope" of the Act. *Id.* at 50. Because that disposition left ISI without a valid federal claim, the Seventh Circuit noted that district court would have been free to dismiss the action for lack of subject-matter jurisdiction over the remaining state law claims. *Id.* Under

well settled law, diversity jurisdiction did not exist because "[o]ne of Scott & Aylen's partners is a U.S. citizen domiciled in Canada; she has no state citizenship[.]" *Id.*

REASONS FOR DENYING THE PETITION

Petitioner contends that this case presents two questions that are worthy of this Court's consideration, but Petitioner fails to present even a plausible reason for this Court to grant the Petition as to either question.

First, in regard to Petitioner's Lanham Act claim, the Seventh Circuit correctly ruled that S&A's letter to APP did not constitute "commercial advertising or promotion" and thus failed to raise even a colorable false advertising claim under the Lanham Act. Petitioner has failed to identify any conflict between that ruling and the decisions of any other Circuit. In fact, the Seventh Circuit's ruling is in line with precedent from the other Circuits. Petitioner's speculation that a conflict may arise in the future is simply a truism, and does not even remotely provide a proper basis for certiorari review by this Court at this time. Finally, even if the Court were inclined to address the merits of the Lanham Act issue, this case would be a poor vehicle for doing so, for two reasons: (i) there is no developed factual record on that issue, and (ii) a single letter to a prospective distributor does not even come close to satisfying the statutory language, pursuant to which the Act applies only to "commercial advertising or promotion."

Second, the Seventh Circuit's ruling that U.S. citizens domiciled abroad cannot be sued on the basis of diversity jurisdiction likewise is entirely correct and consistent with well established law, including decisions of this Court on which the Seventh Circuit panel relied. Again, Petitioner has failed to identify any decisional conflict warranting this Court's review.

Moreover, even if either of the issues presented in the Petition raised a question on which the lower courts are divided or that required an exercise of this Court's supervisory authority, this would not be an appropriate case for certiorari presenting that issue—because the Seventh Circuit's Lanham Act ruling and the jurisdictional consequences that followed from that ruling were simply an alternative basis for affirming the district court's *forum non conveniens* dismissal. Accordingly, a grant of certiorari and a reversal as to the questions presented would not change the outcome of this case. This Court does not exercise its discretion to review cases in which its rulings will have no concrete effect on the disposition of the case in the lower courts. *See, e.g., Sommerville v. United States*, 376 U.S. 909 (1964) (certiorari denied because resolution of conflict would not change the result below).

I. THIS COURT SHOULD DENY CERTIORARI ON THE LANHAM ACT QUESTION.

Because review on writ of certiorari is a matter of judicial discretion rather than right, "[a] petition for a writ of certiorari will be granted only for compelling reasons." Sup. Ct. R. 10. One compelling reason is a circuit split. Sup. Ct. R. 10(a). However, Petitioner has not identified any existing differences between the circuits, but merely speculates that "other circuits * * * might not agree with the seventh circuit's interpretation" of the Lanham Act, which "would only *create* unacceptable differences between the circuits." Pet. at 17 (emphasis added). Petitioner also speculates that "the seventh circuit's erroneous construction * * * may be accepted by other federal courts, thereby perpetuating an error which is at odds with the congressional intent in adopting that language." *Id.*

This Court grants certiorari to resolve actual conflicts, not to correct supposed errors or to address the speculative

hope of one litigant. Robert L. Stern, *Supreme Court Practice*, § 4.3, at 225 (BNA 8th ed. 2002) ("[T]here must be a real or 'intolerable' conflict on the same matter of law or fact."). The speculation on which the Petition rests speaks volumes about the current, settled state of the law and the absence of any reason for this Court to review the Seventh Circuit's decision.

A. Petitioner's Legislative History Argument Is A Red Herring.

Petitioner's heavy (and misplaced) reliance on legislative history demonstrates the absence of merit in its Petition. The Lanham Act does not define the statutory terms "advertising" and "promotion," and the Act's legislative history provides no indication that those terms should be given any meaning other than their ordinary, everyday meaning. Traditional advertising campaigns in print and broadcast media that result in widespread, public communications to consumers clearly fall within the statutory terms. The communication at issue here lies before the start of the other end of the definitional spectrum: it is based on a single private letter to one prospective U.S. distributor. The Seventh Circuit correctly determined that ISI's Lanham Act claim "fails on the merits" because "letters sent to customers do not come within the scope of § 43(a)(1)(B)—which is limited to false or misleading 'commercial advertising or promotion' and does not cover all deceitful business practices." Pet. App. 50.

Petitioner urges this Court to grant certiorari and to reverse the dismissal of its complaint because of a supposed "erroneous construction of section 43(a)(1)(B) * * * which negates the underlying legislative intent of congress." Pet. at 13. However, in a maneuver that underscores the clear absence of any reason to grant the Petition here, ISI's argument focuses not on the merits of the Seventh Circuit's

decision *in this case*, but rather on a supposed error committed by a prior Seventh Circuit panel in *First Health Group Corp. v. BCE Emergis Corp.*, 269 F.3d 800 (7th Cir. 2001).

In *First Health*, the Seventh Circuit rejected a district court approach that "treated 'commercial advertising and promotion' as a synonym for all commercial speech that the first amendment allows the federal government to regulate." *Id.* at 803. In the case at bar, the Seventh Circuit, citing *First Health*, held that "letters sent to customers do not come within the scope of § 43(a)(1)(B)[.]" 316 F.3d at 733.

Petitioner contends that the *First Health* court engaged in "erroneous speculation" when it stated that:

> The language and structure of § 43(a)(1)(B) do not suggest a line between commercial and political speech, with the former completely covered and the latter not. They suggest a line between varieties of commercial speech.

First Health, 269 F.3d at 803. According to Petitioner, that statement stands in "diametric opposition" to Congressional intent, as evidenced by the statements of a single Senator, Dennis DeConcini, the Senate co-sponsor of the Trademark Law Revision Act of 1988. Pet. at 12. In essence, Petitioner asks this Court to determine, on the basis of Senator DeConcini's floor statement, that "commercial advertising and promotion" really means "commercial speech."[3]

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[3] Petitioner gives Senator DeConcini's statement dispositive weight. But just last year, this Court counseled "were we to adopt this form of statutory interpretation, we would be placing an obligation on Members of Congress not only to monitor their colleague's floor statements but to read every word of the Congressional Record including written explanations inserted into the (continued...)

ISI misinterprets Senator DeConcini's statement. That statement only addresses the definition of "commercial," which precedes and qualifies "advertising or promotion" in § 43(a)(1)(B): "It is also Congress' intent that the 'commercial' language be applicable anytime there is a misrepresentation relating to goods or services." Pet. at 12-13. Notably, Senator DeConcini did not discuss the terms "advertising" and "promotion" in the passages cited by Petitioner. In fact, none of the legislative history surrounding the enactment of the Trademark Law Revision Act of 1988 even purports to define "advertising or promotion."[4]

Petitioner also contends that the *First Health* court failed to recognize that "advertising and promotion" was not added to the statute until 1988. That is immaterial. Indeed, far from undermining the *First Health* court's decision, the fact that "advertising" and "promotion" were added to the Lanham Act in 1988, rather than in 1946, fully supports the *First Health* court's observation that "[a]ny plan to occupy all of the constitutionally permitted space would have used the phrase 'commercial speech,' rather than 'advertising or promotion' in § 43(a)(1)(B)[.]" 269 F.3d at 803. By 1988, commercial speech had become a well recognized category of First Amendment activity, and this Court

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[3] (...continued)
record. This we will not do. The only 'evidence' that we need rely on is the clear statutory text." *Barnhart v. Sigmon Coal Co., Inc.*, 534 U.S. 438, 457 n.15 (2002).

[4] Nor was there Congressional consensus on the meaning of "commercial" within § 43(a)(1)(B). While Senator DeConicini intended the term to cover all but political speech, Representative Kastenmeier, the Act's sponsor in the House of Representatives, also excluded "consumer or editorial comment, parodies, satires, or other constitutionally protected material" from the definition of "commercial." 134 Cong. Rec. 31850-52 (Oct. 19, 1988), 134 Cong. Rec. H 10420 (daily ed. Oct. 19, 1988).

had recognized "advertising and promotion" as a species of commercial speech. *See, e.g., Bates v. State Bar of Arizona*, 433 U.S. 350 (1977); *Cincinnati v. Discovery Network*, 507 U.S. 410, 422-24 (1993). *First Health* is correct, and Petitioner's argument is nonsensical: if Congress intended the Lanham Act to regulate all commercial speech, it would not have included the terms "advertising or promotion" in the 1988 revisions to § 43(a)(1)(B). In short, to the extent that Petitioner really seeks review not of the decision below in this case, but of *First Health*, such review is manifestly unwarranted.

B. Adopting Petitioner's View of "Commercial Advertising Or Promotion" Would Lead To Preposterous Results.

Petitioner's premise—that "commercial advertising or promotion" excludes only political speech, regardless of whether the speech occurs in "advertising or promotion" or in an isolated private communication—strips the statutory terms of any meaning. "Advertising" and "promotion" "appear[ ] to be [ ] unlikely term[s] for Congress to have employed if it had intended to include isolated communications within the Act's purview." *Garland Co. v. Ecology Roof Sys. Corp.*, 895 F. Supp. 274, 276 (D. Kan. 1995). "Promotion is defined as 'active furtherance of sale of merchandise through advertising or other publicity. * * * [A]n analysis of the history and purpose of the Lanham Act is of little value in attempting to determine whether Congress meant any broader definition of 'promotion' than that suggested by Webster's." *Id.* (citing Webster's Third New International Dictionary, at 1815 (1986)).

Adopting Petitioner's definition of "commercial advertising or promotion" would transform every commercial fraud case into a federal Lanham Act "false advertising" claim. The Seventh Circuit properly relied on the plain meaning

of the statutory terms in rejecting Petitioner's strained construction. In this Court's words, "courts should strive to avoid attributing absurd designs to Congress, particularly when the language of the statute and its legislative history provide little support for the proffered, counterintuitive reading." *Sheridan v. United States*, 487 U.S. 392, 402 (1988).

C. The Lanham Act Does Not Encompass All Commercial Speech.

Not surprisingly, other circuits define "advertising" and "promotion" by distinguishing between (i) those types of commercial speech and (ii) other private, isolated types of commercial speech. As the Tenth Circuit explained, "these terms by their plain, everyday meaning connote *some* level of *public* dissemination of information." *Sports Unlimited, Inc. v. Lankford Enters.*, 275 F.3d 996, 1005 (10th Cir. 2002) (citation omitted). In sum, "commercial advertising and promotion" does not encompass all commercial speech. Unless Congress decides to amend those terms, they must be given their plain meaning, as the Seventh Circuit has done both in the decision below and in *First Health*.

II. THIS COURT SHOULD DENY CERTIORARI ON THE SUBJECT-MATTER JURISDICTION QUESTION.

After determining that ISI's sole federal claim fails on the merits, the Seventh Circuit correctly held that the district "court would be free to relinquish supplemental jurisdiction" because "[o]ne of Scott & Aylen's partners is a U.S. citizen domiciled in Canada; she has no state citizenship, so the diversity jurisdiction is unavailable." Pet. App. 50 (citing *Newman-Green, Inc. v. Alfonzo-Larrain*, 490 U.S. 826, 829 (1989)).

It is black letter law that diversity jurisdiction requires the presence of citizens of different states, and that citizenship is determined by a person's "domicile." *See, e.g., Crowley v. Glaze*, 710 F.2d 676, 678 (10th Cir. 1983). Domicile is determined by weighing various factors. No single factor is dispositive, but if a person lives and works in a state (or foreign country) and plans to remain there indefinitely, that state (or foreign country) is considered the person's domicile. *See, e.g., Mississippi Band of Choctaw Indians v. Holyfield*, 490 U.S. 30, 48 (1989) (domicile is combination of physical presence in a location and an intent to remain there indefinitely).

The test for domicile is fact intensive, but in this case it is not a close call. Petitioner does not dispute the Seventh Circuit's conclusion that Carole Brown, a partner in both BESA and BLG, is a U.S. citizen domiciled in Canada.[5] Ms. Brown has lived and worked in Canada since 1975, is married to a Canadian citizen, and plans to remain in Canada indefinitely. Pet. App. 54-56.

After properly determining that Ms. Brown is domiciled in Canada, the Seventh Circuit applied this Court's settled precedent by holding that, as a U.S. citizen domiciled abroad, Ms. Brown is not considered a citizen of any U.S. state for diversity purposes, and therefore complete diversity is lacking.[6] Pet. App. 50. Petitioner acknowledges, as it must, that the Seventh Circuit's ruling was a correct

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[5] Petitioner acknowledges that Ms. Brown is domiciled abroad, and its "Questions Presented" assume a U.S. citizen domiciled abroad. Pet. at i and 16.

[6] Petitioner states, erroneously, that the Seventh Circuit established a conclusive presumption that every U.S. citizen *living* abroad is not a citizen of any state. Pet. at 16. Petitioner fails to recognize the distinction between residence and domicile. Temporary residence, with no intent to remain indefinitely, does not change a person's domicile. The two terms are not synonymous; "domicile" requires an intent to remain indefinitely.

application of settled law: "it has been held *consistently* that a diversity suit may not be maintained under Section 1332(a)(1) by or against a United States citizen domiciled in a foreign country." Pet. at 14 (citing 13B Wright, Miller & Cooper, *Federal Practice and Civil Procedure* 2d, § 3621, at 577-78 (West 1984) (emphasis added).

Undaunted, Petitioner asks this Court to announce a new rule: even if all of the relevant factors indicate that a U.S. citizen is domiciled in a foreign country, those factors *must be set aside*, and the person must be deemed a citizen of a U.S. state, if the citizen exercises her U.S. citizenship by voting in a presidential election. In effect, Petitioner asks the Court to hold that voting is the *only* domicile factor that matters, or that this Court's precedent should be narrowly limited to foreclosing the availability of diversity jurisdiction for a "traditional, stateless 'ex patriot' [sic] who has severed ties with the U.S." Pet. at 17-18.[7] Petitioner believes this precedent-overturning result is justified because: (i) some older cases held that voting raises a rebuttable presumption of citizenship in a state, and (ii) voting for a state's electors to the electoral college allegedly demonstrates an intention not to terminate a person's status as a citizen of that state. In support of its plea for review, Petitioner submits that its request "transcends the facts of this case" and that the Court's ruling would affect "thousands of U.S. citizens living abroad, including those who are serving in the armed services of the United States and who are stationed, with their families, overseas" who otherwise would be prevented from maintaining domicile in a state, and thus have to forego "their 'constitutional right to come into the courts

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[7] The source of Petitioner's imagined "traditional" U.S. citizen abroad who has "severed all ties to the U.S." is unclear. *Newman-Green, Inc. v. Alfonzo-Larrain*, 490 U.S. 826 (1989), has never been restricted to expatriates with *no* ties to the U.S.

of the Union.'" Pet. at 18 (citing *Cohens v. Virginia*, 19 U.S. 264 (1821)).

ISI's bizarre request to assert the rights of strangers to this case in their hypothetical attempts to "come into the courts of the Union" presents no question worthy of this Court's attention. Petitioner does not cite any case that actually supports its novel contentions, much less demonstrates the existence of tension or a split in the Circuits on any diversity jurisdiction issue even remotely connected to this case. The Circuits, including the Seventh Circuit in this case, adhere to this Court's clear precedent.

The merits of Petitioner's argument also do not warrant this Court's time. To begin with, Petitioner's emphasis on an expatriate's voting record is misplaced. Rather than being the touchstone that Petitioner imagines, voting has become a *less significant* factor in the domicile analysis under modern law. Because Supreme Court decisions have greatly reduced residency requirements for voting registration, this factor now carries less weight. 13B Wright, Miller & Cooper, *Federal Practice & Procedure*, § 3612, at 535. Voting requirements are simply not a substitute for this Court's traditional domicile test.[8] Even the older decisions on which Petitioner relies did not give voting the outcome determinative weight that Petitioner desires; modern decisions give voting even less weight. *See, e.g., Abbott v. United Venture Capital, Inc.*, 718 F. Supp. 823 (D. Nev. 1988) (despite Nevada voting, plaintiff was a Californian because of primary residence). Moreover, even if voting were the touchstone that Petitioner imagines it

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[8] U.S. citizens domiciled abroad can vote in elections for federal office under The Uniformed And Overseas Citizens Absentee Voting Act. 42 U.S.C. § 1973-ff1. The Act allows these citizens to vote in the state where they last resided, even if many years have elapsed and the citizen does not maintain any residence in the state.

to be, Ms. Brown's voting record does not diminish the Seventh Circuit's determination that she is domiciled in Canada. Although Ms. Brown votes only in federal elections in the United States, she votes "in municipal, provincial, and federal elections in Canada." Pet. App. 56.

Petitioner's argument that the issue "transcends the facts of this case" is a non-starter. Because domicile is a fact-intensive determination and no one factor is outcome determinative, granting review in the unusual circumstances present here would not yield a decision with widespread application in other cases. Even if Petitioner were an appropriate party to act on behalf of military personnel stationed overseas, Petitioner's professed concern about the ability of such persons to litigate in federal court under the diversity statute is misplaced.

It is well established that "[a] citizen of a state does not change his citizenship by entering military service even though he is assigned to duties in another state or country, and regardless of the term of service, unless he indicates an intent to abandon such original domicile and adopt a new one." *Seegers v. Strzempek*, 149 F. Supp. 35, 36 (D. Mich. 1957); *accord*, *Beers v. North American Van Lines,* Inc., 836 F.2d 910 (5th Cir. 1988); *Ellis v. Southeast Constr. Co.*, 260 F.2d 280 (8th Cir. 1958); *Price v. Greenway*, 167 F.2d 196 (3rd Cir. 1948). Thus, military personnel stationed overseas generally retain their state domicile. A party seeking to show that a serviceperson has acquired a new domicile—domestic or foreign—must present clear and unequivocal evidence in the face of the serviceperson's contradictory declarations. Wright, Miller & Cooper, *Federal Practice & Procedure* 2d, § 3617, at 567. U.S. citizens living in foreign countries, including U.S. military personnel, can retain their state domicile simply by refraining from making a statement of their intention to remain indefinitely or permanently in such foreign country. *See, e.g.*, *Maple Island*

Farm, Inc. v. Bitterling, 196 F.2d 55, 59 (8th Cir. 1952), *cert. denied*, 344 U.S. 832.

Petitioner's real concern—that without a federal cause of action, it cannot sue Respondents in federal district court because Ms. Brown is domiciled in Canada—is not an issue of far-reaching significance. The membership of the class of U.S. citizens domiciled abroad "admittedly is extremely small[.]" 13B Wright, Miller & Cooper, *Federal Practice & Procedure* 2d, § 3621, at 580. Moreover, if Petitioner wishes to seek redress, its remedy lies with Congress, not with this Court.[9] Certiorari should be denied.

III. THIS CASE WOULD BE A POOR VEHICLE FOR ADDRESSING PETITIONER'S QUESTIONS IN ANY EVENT.

Finally, even if either of the issues presented in the Petition raised a question on which the lower courts are divided or required an exercise of this Court's supervisory authority, this case presents a poor vehicle for review. To begin with, the Seventh Circuit's Lanham Act ruling and the jurisdictional consequences that followed from that ruling were simply an alternative basis for affirming the district court's *forum non conveniens* dismissal. Petitioner does not seek review or reversal in this Court of that independent basis on which the district court's decision in this case was upheld. As a result, a grant of certiorari would have no concrete effect on the disposition of the

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[9] Despite the limited ramifications of the rule that Petitioner seeks to overturn, Congress *could* amend the diversity statute to reach the result that Petitioner desires. 13B Wright, Miller & Cooper, *Federal Practice & Procedure*, § 3621, at 581. Congress previously amended the statute so that citizens of the District of Columbia, Puerto Rico, and the territories are deemed citizens of a "state" under 28 U.S.C. 1332(d). *Id.*

case in the lower courts, regardless of this Court's ruling on the questions presented.

A. The Seventh Circuit Only Ruled On The Lanham Act Issue As An Alternative Basis For Affirming The *Forum Non Conveniens* Dismissal.

Although the Seventh Circuit questioned the district court's reasoning for dismissing the case on *forum non conveniens* grounds, the Seventh Circuit ultimately affirmed that dismissal. As the court explained, notwithstanding its doubts about the district court's rationale,

> two additional considerations lead us to conclude that the district court did not abuse its discretion in relegating ISI International to the Canadian forum. First, Scott & Aylen no longer exists. It was succeeded as part of a merger by Borden Elliot Scott & Aylen, and although this partnership continues to exist all of its partners practice through Borden Ladner Gervais, LLP, the survivor. The parties dispute which among the entities, and who among the individual partners, is liable for Scott & Aylen's debts. The district judge was unable to resolve this question, the parties have not reached agreement on it, and an Ontario court may have to do so no matter what, if an effort is made to collect in Ontario any eventual judgment. If this aspect of the parties' dispute is going to land in Ontario no matter what, why not handle the whole suit there?

Pet. App. 49. And, second, Petitioner's Lanham Act claim was untenable and its dismissal would leave nothing in the case other than the state law claims, which the district court was free to dismiss for lack of subject matter jurisdiction. *Id.*

As the court made clear, dismissal was appropriate in the first place because the key legal issue of successor liability

ultimately would have to be resolved in Canada. Because Petitioner does not challenge that ruling, reversal of the Seventh Circuit's Lanham Act and subject-matter determinations would not change the result below—dismissal on *forum non conveniens* grounds.

B. There Is No Developed Factual Record On The Lanham Act Issue.

This case would be a poor vehicle for addressing the Lanham Act issue because the record as to that issue was underdeveloped. The Lanham Act issue clearly was not a central issue in the district court proceeding. Indeed, in view of its dismissal on *forum non conveniens* grounds, the district court did not even address the Lanham Act. In the Seventh Circuit, Respondents argued that the *forum non conveniens* dismissal could be affirmed on the alternative Lanham Act and subject-matter jurisdiction grounds addressed in the Seventh Circuit's subsequent opinion. But both Petitioner and Respondents devoted the majority of their arguments to the *forum non conveniens* issue. Petitioner did not make the Lanham Act argument that it now advances in this Court. Under these circumstances, certiorari is inappropriate. *See, e.g., Adams v. Robertson*, 520 U.S. 83, 91-92 (1997) (reversing grant of certiorari due to lack of developed record).

C. The Facts Of This Case Do Not Present A "Close Call."

Finally, Petitioner's Lanham Act claim is exceedingly weak on the merits. Petitioner's claim is based on a single letter to APP in California. That lone letter does not even come close to meeting any conceivable, ordinary speech definition of "commercial advertising or promotion." The letter was a purely private communication. There was no

element of publicity involved. The letter was sent only to a potential manufacturer/distributor, not to a customer. And, contrary to Petitioner's assertion (Pet. at 6), the letter did not solicit the recipient to do business with Dr. Reitsma instead of ISI. Pet. App. 52-53.

CONCLUSION

For all of the foregoing reasons, Respondents respectfully request that this Honorable Court deny the Petition.

Respectfully submittted,

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